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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,212	06/15/2001	Holger Birk	016790-0425	5119

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EXAMINER

NEGRON, ISMAEL

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/881,212	Applicant(s) BIRK ET AL. <i>9/11</i>
Examiner	Art Unit 2875	
Ismael Negron		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 June 2001 .

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4, 6-18, 20 and 21 is/are rejected.

7) Claim(s) 5, 22 and 23 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 June 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) ✓
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6 ✓
4) Interview Summary (PTO-413) Paper No(s). _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Title

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: **Laser Illuminator and Method.**

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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2. The abstract of the disclosure is objected to because it uses language that can be implied. Correction is required. See MPEP § 608.01(b).

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "79" has been used to designate "object" (page 11, line 26), "non-transparent object" (page 11, line 26), "biological objects" (page 11, line 27) and "transparent objects" (page 11, line 28). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The applicant is advised that the reference characters must be properly applied, with no single reference character being used for two different parts or for a given part and a modification of such part. See MPEP §608.01(g). Correction is required.

Applicant is further advised that this action only exemplifies the objections to the drawings, applicant's cooperation is requested in correcting all the occurrences of the cited, or any other errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is indefinite as it is not clear what the applicant is claiming with the phrase "consist essentially of" (line 2). The use of the word "essentially" in claims has been held to be definite if the specification contains guidelines and/or examples to define the scope of the claim. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (CCPA 1983). In this case, the detailed description of the claimed invention lacks any explanation of what are "essentially" the constituents of the claimed microstructured optical element.

In addition, the claim language is presented in an improper Markush group. See MPEP § 2173.05(h).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-4, 6-18, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ranka et al. (U.S. Pat. 6,097,870).

Ranka et al. discloses an illumination device having :

- **a laser for generating a light beam**, Figure 9, reference number 92;
- **a microstructured optical element for receiving the light beam**
- **a laser for generating a light beam**, Figure 9, reference number 96;
- **the microstructured element spectrally broadening the light beam**, column 7, lines 11-38;
- **optical means for shaping the spectrally broadened light beam**, Figure 9, reference number 96.2;
- **the light beam being directed to illuminate an object**, inherent;
- **means for selecting at least one wavelength from the broadened beam and directing it to the object**, column 7, lines 39-51;
- **means for adjusting the power of the broadened beam**, column 7, lines 7-10;
- **means for adjusting the spectral composition of the beam**, column 7, lines 18-38;
- **the beam being composed of a plurality of pulses**, column 6, lines 14-17;

- **means for adjusting the width of the pulses**, column 9, lines 52-58;
- **means for adjusting the chirp of the pulses**, column 10, lines 17-20;
- **the microstructure element having a plurality of micro-optical structure elements**, Figure 1, reference number 14;
- **the micro-optical structure elements having at least two different optical densities**, column 4, lines 1-5;
- **the microstructure optical element having a first region with a homogenous structure and a second region formed by the micro-optical structure elements**, Figure 1;
- **the first region enclosing the second region**, Figure 1, reference number 16;
- **the microstructure optical elements being formed by at least one selected from the group consisting of adjacent glass, plastic material, cavities, cannulas, webs, honeycombs or tubes**, column 4, lines 10-13;
- **the microstructured element consisting of a photonic band gap material**; and
- **the microstructured element being configured as an optical fiber**, column 2, lines 14-24.

In addition, the Examiner take Official Notice of Applicant's statement conceding that Ranka et al. teaches an illumination device having a laser, a microstructured fiber, the laser light being broadened in the fiber by non-linear effects, and the use of photonic band gap materials as microstructured fibers. See page 1, lines 14-20 of the specification as filed.

Allowable Subject Matter

5. Claims 5, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office Action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

7. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches an illumination apparatus having a laser, a microstructured optical device, means for spectrally broadening and shaping the laser beam to direct illumination onto a object, such apparatus also including means to adjust the polarization of the spectrally broadened laser beam, or the microstructured optical device being a tapered fiber.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (703) 308-6086. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (703) 305-4939. The facsimile machine number for the Art Group is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Inr

June 24, 2002



THOMAS M. SEMBER
PRIMARY EXAMINER